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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/550,937

09/28/2005

Atsumi Mori

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EXAMINER

KARPINSKI, LUKE E

ART UNIT

PAPER NUMBER

1616

MAIL DATE

DELIVERY MODE

05/13/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/550,937	Applicant(s) MORI ET AL.	
	Examiner LUKE E. KARPINSKI	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 January 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3 and 5-8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3, and 5-8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt of amendments, arguments, and remarks filed 1/12/2009 is acknowledged.

Claims

Claims 2, 4, and 9-12 are canceled.

Claims 1, 3, and 5-8 are currently pending and under consideration in this action.

Claims 1 and 3 are amended.

Rejections

Rejections and/or objections not reiterated from previous office actions are hereby withdrawn. The following rejections and/or objections are either reiterated or newly applied. They constitute the complete set presently being applied to the instant application.

Maintained Rejections

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 1616

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Applicant Claims
2. Determining the scope and contents of the prior art.
3. Ascertaining the differences between the prior art and the claims at issue, and resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1, 3, and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Patent No. 5,612,021 to Mellul.

Applicant Claims

Art Unit: 1616

Applicant claims a composition comprising 1-30% wax, 0.1-25% resin, 0.01-20% hollow resin powder, wherein the hollow resin powder has a specific gravity of 0.02 to 0.65.

Further claimed by applicant is a ratio of said components, a colorant, a thickener, and a specific gravity and hardness of said compositions.

Determination of the Scope and Content of the Prior Art (MPEP §2141.01)

Mellul teaches mascaras (col. 1, lines 12-13), 0.1-50% and 15% wax (col. 5, line 52 to col. 6, line 33 and example 3), 0.5-15% resin (col. 7, lines 1-6), 0.5-30% hollow organic powder (col. 3, line 36 to col. 4, line 21), as claimed in claim 1. It is noted by the examiner that Expancel is a line of hollow inorganic powders having specific gravities within said claimed range, as evidenced by the Expancel product specification sheet provided with this action.

Mellul further teaches said composition comprising 0.5-30% colorant, (col. 3, lines 36-37), as pertaining to claim 5, and 0.5% gum arabic (example 1), which reads on claim 6.

Ascertainment of the Difference between Scope the Prior Art and the Claims (MPEP §2141.012)

Mellul does not explicitly teach an example wherein the claimed ingredients and percentages are combined in a single formulation. However, Mellul does teach all of the claimed components within the claimed percentage ranges.

Finding of Prima Facie Obviousness Rational and Motivation

(MPEP §2142-2143)

Regarding claims 1, 5, and 6, it would have been obvious to one of ordinary skill in the art at the time the claimed invention was made to select said ingredients and combine them as instantly claimed because Mellul suggests that the instant ingredients can be combined mixed together. In a prior art reference it is not necessary for all the possible compositions to be exemplified in the examples in order for the art to render an invention obvious.

One of ordinary skill in the art would have been motivated to combine said ingredients because Mellul teaches that it may be done. Therefore it would have been obvious to combine the instant ingredients into a single formulation as taught by Mellul.

Regarding claim 3 and the instantly claimed ratio, it would have been obvious for one of ordinary skill in the art at the time of the invention to produce the formulations of Mellul with the ratio of instant claim 3.

One of ordinary skill would have been motivated to do this because Mellul teaches percentage ranges for each of the 3 components in said ratio. It is considered routine optimization for one to simply alter the percentages of components in a formulation and it would have been expected that one of ordinary skill would have done so in order to achieve the desired properties. It is the examiner's position that the claimed ratio is so broad that utilization of a majority of the percentages of the wax, resin, and hollow resin powder, would necessarily fall within the claimed ratio range.

Regarding claims 7 and 8, Mellul teaches the same components present within the claimed ranges. Compositions and their properties cannot be separated.

Art Unit: 1616

Therefore, the compositions of Mellul necessarily have the properties claimed in instant claims 7 and 8.

From the teachings of the reference, it is apparent that one of ordinary skill in the art would have had a reasonable expectation of success in producing the claimed invention. Therefore, the invention as a whole would have been prima facie obvious to one of ordinary skill in the art at the time the invention was made, as evidenced by the references, especially in the absence of evidence to the contrary.

It is noted that applicant has amended the percentages of said components, however, the same references and citations within said references still render the instant claims obvious.

Response to Arguments

Applicant's arguments filed 1/12/2009 have been fully considered but they are not persuasive.

Applicant argues that the fullerenes of Mellul cannot be equated to the hollow resin powders of the instant claims.

Although Mellul does teach the inclusion of fullerenes, these compounds were not utilized to show the instant claims obvious. The hollow resin powders equating to those of the instant invention are the Expancel microspheres (col. 4, lines 16-21). In light of the fact that Expancel microspheres are hollow resin powders with specific

Art Unit: 1616

gravities within the claimed range, all other arguments to fullerenes and to the absence of hollow resin powders in Mellul are found non-persuasive.

Conclusion

Claims 2, 4, and 9-12 are canceled.

Claims 1, 3, and 5-8 are rejected.

No claims are allowed.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to LUKE E. KARPINSKI whose telephone number is (571)270-3501. The examiner can normally be reached on Monday Friday 9-5 est.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann R. Richter can be reached on 571-272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

LEK

/Mina Haghighatian/
Primary Examiner, Art Unit 1616